

REMARKS

Claims 5 and 8-12 are pending in the application, with claims 5 and 8 being the independent claims. Claims 5 and 8-12 are sought to be amended. Claims 1-4, 6 and 7 were cancelled by previous amendment without prejudice to or disclaimer of the subject matter therein.

Claims 5 and 8 have been amended to recite that the dipeptidyl peptidase IV inhibitor is used to close an ATP-sensitive K⁺ channel that has become unable to be closed as a result of stimulation by a sulfonylurea receptor 1-binding compound. Claims 8-12 have also been amended to recite that the sulfonylurea receptor 1-binding compound is a sulfonylurea compound or a fast-acting insulin secretagogue. Support for these amendments can be found in the specification as originally filed, e.g., at page 38, lines 3-15; page 39, lines 3-5; and page 47, lines 1-14.

These changes are believed to introduce no new matter, and their entry is respectfully requested. Applicant respectfully requests reconsideration of this application in view of the comments that follow.

I. Rejection Under 35 USC § 103

The Examiner rejects claims 5 and 8-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ahrén *et al.*, *Eur. J. Pharmacol.* 404:239-245 (2000) ("Ahrén 2000") in view of Nauck *et al.*, *Diabetes Care* 21:1925-1931 (1998) ("Nauck"). (Office Action, dated July 3, 2008, at page 2, lines 19-21.) Applicant respectfully traverses this rejection.

Specifically, the Examiner contends that Nauck teaches that a similar glucose threshold for GLP-1-induced insulin secretion is still active in patients with true sulfonylurea secondary failure, and that, as a consequence, one of ordinary skill in the art would have a reasonable expectation that treating a diabetic patient with secondary sulfonylurea failure with a DPP-IV inhibitor would be successful at preserving endogenous GLP-1 levels, which results in stimulation of insulin secretion in the patients. (Office Action, at page 3, lines 6-12.)

To expedite prosecution and without acquiescing to the propriety of the rejection, and also to clarify the recited invention, Applicants have amended claims 5 and 8 to indicate that the recited dipeptidyl peptidase IV inhibitor is used to close an ATP-sensitive K⁺ channel that has become unable to be closed as a result of stimulation by a sulfonylurea receptor 1-binding compound.

Applicants submit that neither Ahrén 2000 nor Nauck disclose or suggest a method of treating diabetes with sulfonylurea secondary failure, or of promoting insulin secretion in a diabetic patient with sulfonylurea secondary failure, by administering a dipeptidyl peptidase IV inhibitor that is used to close an ATP-sensitive K⁺ channel that has become unable to be closed as a result of stimulation by a sulfonylurea receptor 1-binding compound. Neither Ahrén 2000 nor Nauck even disclose or suggest that a dipeptidyl peptidase IV inhibitor can be used to close an ATP-sensitive K⁺ channel in a diabetic patient with sulfonylurea secondary failure.

Thus, there would have been no reason for one of skill in the art, in view of Ahrén 2000 and Nauck, to arrive at Applicant's claimed methods of treating diabetes with sulfonylurea secondary failure or of promoting insulin secretion in a diabetic patient with sulfonylurea secondary failure. Accordingly, the methods as presently claimed would not have been obvious in light of Ahrén 2000 and Nauck.

Applicant believes that the rejection of claims 5 and 8-12 under 35 U.S.C. § 103 has been overcome. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

CONCLUSION

Based on the foregoing remarks, Applicant respectfully requests that the Examiner reconsider all rejections and that they be withdrawn. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date March 2, 2009

By Ann E. Summerfield

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Ann E. Summerfield
Attorney for Applicant
Registration No. 47,982